UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,770	04/11/2001	Carlos De La Huerga	250591.90279	2242

7590 08/03/2007

Michael A. Jaskolski
Quarles & Brady, LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202

EXAMINER	
MISKA, VIT W	
ART UNIT	PAPER NUMBER
2833	

MAIL DATE	DELIVERY MODE
08/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/832,770	DE LA HUERGA, CARLOS	
	Examiner	Art Unit	
	Vit W. Miska	2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5,7-10 and 12-153* is/are pending in the application.

4a) Of the above claim(s) *12-14,16,18-21,30-32,34,35,37-106 and 109-153* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,7-10,15,17,22-29,33,36,107,108* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/1/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 27-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the limitation ""sensor surface " in lines 4-5 (following the deleted portions). There is insufficient antecedent basis for this limitation in the claim.

Claim 28 lacks antecedent basis for "the sensing surface" (line 2).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 4, 5, 9-10, 28-29 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Yarin et al (6,294,999). The reference discloses a medication system for performing health safety functions including containers 34 for holding doses of medication, the containers having RF memory device 50 containing specifying information useable to determine a prescribed dosing regimen for the medication (see col. 7, lines 39ff and col. 9, lines 7ff), communication device 36 or 36' (Fig. 13), RF sensors 41 (antennae) defining sensing areas associated with each receptacle 32 for receiving the specifying information, processor 40 receiving the specifying information to identify a prescribed dosing regimen (col. 7, lines 8-9, col. 9, lines 7-20), timing device inherently associated with processor 40 (col. 6, lines 33-34, col. 10, line 60) and necessary to produce the time alerts for the medication, the processor causing the communication means 36 to indicate predetermined times for taking medication, thus performing a health safety function, col. 10, line 66, the processor using the specifying information to determine a predetermined time for taking medications (col. 5, line 31), horizontal senor surface 30 associated with the processor, container 34 with downward

surface 34a and RF tag 50 attached thereto, aligners 32 for distinguishing sensing and non-sensing sections.

3. With respect to claim 4, the aligner "indicia" correspond to the circular outlines of the aligners (receptacles) 32 or the green LED's 36 (col. 8, line 37) indicating presence of a container. With respect to claims 9 and 10, the indicia correspond to the outlines of aligners (receptacles) 32 having the shape of the downward facing surface 34a.

4. With respect to claim 28, the sensing sections correspond to the positions of sensors 41 adjacent receptacles 32, and the non-sensing sections correspond to the areas of surface30 with no receptacles and sensors.

5. Regarding claim 33, processor 40 causes the sensor to scan the sensing area to identify specifying devices therein (col. 6, lines 51-52).

6. Claims 4, 5, 9-10, 28-29 and 33 are not accorded the benefit of the filing date of the CIP application 09/185,137, U.S. Patent 6,259,654 for the reasons set forth in the previous Office actions, and, therefore, the Yarin et al reference is a proper reference under 35U.S.C. 102(e).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 107 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn (5774865).

The reference discloses an apparatus and method for performing health safety functions including containers 1,2,4 for holding doses of medication, machine readable and writable memory strips 3,5,7, respectively, containing specifying information (medicine identity, col. 4, line 38) usable to determine a prescribed dosing regimen (col.4, line 57-58), sensor 13 with sensor area 9 for receiving several specifying devices 3,5,7 receiving the specifying information, sensor 13 linked to processor 21 (Fig. 4B), using the information to identify a prescribed dosing regimen (col. 5, line 18), and performing a health safety function (alarm reminders, col. 5, line 29).

The specifying information is disclosed as being at least the identity of the medication (col. 4, line 38). Processor 21 stores dosage regimens for each of the medications (col. 4, line 58, col. 5, line 18.

8. It is apparent from the description that sensor 13 receives the specifying information (medicine identity) of each container and stores a prescribed dosing regimen for each medication containers. It would be obvious for one of ordinary skill in the art to recognize that the specifying information (medicine identity) is received by the processor from the specifying devices for the purpose of "identifying" or "determining" a prescribed dosing regimen for each corresponding medication container. The claim does not require that the specifying information include the dosing regimen, but only

that the specifying information be used to "identify" or "determine" the dosing regimen. In Glynn, the medicine identity provided by the sensor is necessary to identify any such dosing regimen.

9. Claim 108 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn in view of Mucciacciaro. With respect to the separate sensing areas, Glynn suggests separate sensors positioned under each container (col. 6, line 46). Regarding separate visual indicators for the medication containers, It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container, as done in the Mucciacciaro device at 12, as an obvious means for prompting the user to take the medication in the correct container.

10. Claims 1, 15, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn (5774865) in view of O'Brien (6150942).

11. In addition to the elements identified in paragraphs 7-8, above, Glynn further discloses processor 21 including an associated surface 9, and retrieves specifying information from each of the memory devices (col. 5, lines 67). Glynn further includes communication device 33, timing means inherently associated with processor 21 for providing the predetermined ties for taking medication (col. 5, lines 18, 29), and the processor using the specifying information (medicine identity) to identify a dosing regime, as noted in par. 6, above.

12. Glynn does not suggest using RF communication for receiving information from the memory devices by the sensor or processor. The preferred embodiment employs bar code labels 3,5,7, and a bar coder reader a sensor 13 for reading labels 3,5,7. However, other alternatives for the bar code type system are suggested at col. 6, lines 21 and 33, including laser transceivers and magnetic media. Thus, one of ordinary skill in the art would be taught to employ suitable available technology for storing medication data in containers 1,2,4 and corresponding retrieving means 9,13. O'Brien has been identified above and teaches use of radio frequency labels RFID on the bottom surface of medication containers (Fig. 7) and corresponding RFID reader 8 for identifying medication therein, as well as bar code labels and readers. One of ordinary skill in the art having both references would therefore have a suggestion of using this type of radio frequency device for storing and retrieving information from the memory device in place of the bar code reader suggested by Glynn, as an obvious alternative for achieving the benefits of radio communication, such as greater reception area and distance, less sensitivity, etc. not associated with optical bar coder readers.

13. Claims 7, 8, 23-27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glynn and O'Brien, as applied to claims 1 and 22, above, in further view of Mucciacciaro (5,239,491). Regarding claims 7, 8 and 27, Glynn does not suggest an aligner for aligning the containers 1 with the surface 9. However, it would be obvious for one of ordinary skill in the art to provide such alignment means, as disclosed in Mucciacciaro with container bottoms 5 corresponding in shape to recesses

13 in surface 2 providing aligner "indicia", or indicia 24 adjacent each container. Such aligners/indicia would be an obvious means for facilitating placement of medication containers 4 into the proper areas.

14. With respect to claims 23-26 and 36, Glynn further does not disclose a communication device for indicating which medication to consume by indicating the containers. Mucciacciaro discloses a medication device with communication devices including separate visual indicators 12 adjacent medication containers indicating the medication to be consumed. It would be obvious for one of ordinary skill in the art having both references, at the time the invention was made, to provide a visual warning indicator in the Glynn system for identifying each container, as done in the Mucciacciaro device at 12, as an obvious means for prompting the user to take the medication from the correct container.

Response to Arguments

15. The argument with respect to O'Brien and claim 1 is moot in view of the new grounds of rejection. However, applicant notes that O'Brien and Glynn fail to teach that the specifying information is received from the specifying device mounted to a container. As noted above with respect to the rejection claims 1 and 107, Glynn receives specifying information of medication identity from labels 3 attached to containers 1. Processor 21 then provides the appropriate dosing alerts for the corresponding medications at appropriate times. Thus, the specifying information from labels 3 is used by processor to "identify" the correct dosing regimen from among the

stored regimes. Applicant is apparently suggesting that the claims imply that the specifying information received from the sensors contain the dosage regimen. The claims only require that the specifying information is used by the processor to identify or determine the dosing regimen. Clearly, the dosage regimen in Glenn could not be determined for each medication container unless some specifying information were received identifying a medication or container.

16. With respect to Yarin et al and the claims rejected thereon, applicant argues that the reference lacks indicia on the sensor surface. As noted above, the indicia correspond to the circular outlines of receptacles 32 having the outlines of the bottom of containers 34, as applied to claim 9, or the same or green LED's 36 on the surface indicating presence of a container. These can be considered provide the function of aligning the containers with a portion or the surface. The "aligners" have not been further defined in the claims to warrant attributing of additional structural limitations not present in the claims.

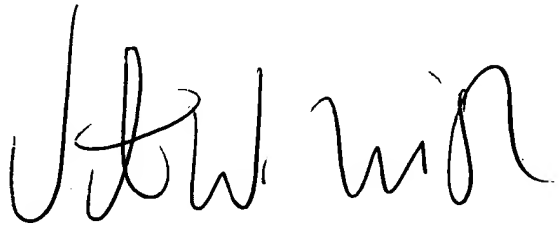
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Bradley can be reached on 571-272-2001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Vit W. Miska
Primary Examiner
Art Unit 2833

VM
8/1/2007